

Remarks

Claims 4 through 7 are presently pending.

A. Claims 4-6 stand rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement because it is asserted that there is no basis in the original specification for a metatarsal guard having no slits therein.

In Ex parte Parks, 30 USPQ2d 1234, 1236 (1983), the Board of Patent Appeals and Interferences held that “[c]learly, the observation of a lack of literal support does not, in and of itself, establish a prima facie case for lack of adequate descriptive support under the first paragraph of 35 U.S.C. 112.” Rather, a lack of adequate descriptive support is established when “the originally-filed disclosure would not have reasonably conveyed to one having ordinary skills in the art that an appellant had possession of the now claimed subject matter.” Id. Accordingly, the Board held, “it is sufficient if the originally-filed disclosure would have conveyed to one having ordinary skill in the art that an appellant had possession of the concept of what is claimed, citing In re Anderson, 471 F.2d 1237, 176 USPQ 331 (CCPA 1973).

In the present case, a person having ordinary skill in the art would have to look no further than the originally-filed drawing to understand that applicant’s concept involved a metatarsal guard having no slits therein. Nevertheless, to place the application in condition for allowance or in better form for appeal, the reference to the metatarsal guard having no slits therein has been deleted from the claims, and replaced by the reference to a metatarsal guard having no space therein for facilitating flexion.

It is respectfully submitted that the new language reciting that the metatarsal guard has no spaces therein for facilitating flexion does not raise any new issues but rather addresses the

Examiner's prior comments regarding the language of the claims.

B. Claims 4-6 stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In view of the present amendment, and for the reasons expressed in section A above, it is respectfully requested that the rejection of claims 4-6 be withdrawn.

C. Claims 4-6 stand rejected under 35 U.S.C. 102(b) as being clearly anticipated by Fortin (5457898). In prior discussions of Fortin, the Examiner asserted "that the fact that the single legs in Fortin includes a slit does not increase the number of legs, and/or the portion forward of the slit can be considered to be a front flange or part of the lip which overlies the toe cap." (See, for example, the 10/7/03 Office Action, page 2). The Examiner now asserts that the front portion forward of the slit 19 is not part of a single leg but instead it may be considered to be a "brace" or forward position. Among other things, that new interpretation ignores the fact that Fortin et al makes no such distinction between the front and rear portions of the slit.

In any event, Fortin's metatarsal guard includes a space (i.e. slits 19) for facilitating flexion and therefore does not anticipate amended claims 4-6, which recite that the metatarsal guard does not have a space for facilitating flexion.

D. Claims 4-6 stand rejected as being anticipated by Krajcir (4908963). It is respectfully submitted that the Examiner's assertion that front element 10 referred to by the Examiner as a lip, does not bear against the sole is incorrect. When a load is applied to the metatarsal guard of Krajcir, the front element 70 (lip) will undoubtedly bear against the sole. To emphasize this point, the amended claims recite that the lip does not bear against the sole when a load is applied to the metatarsal guard. It is respectfully urged that claims 4-6 are not anticipated by Krajcir.

E. Claims 4-6 stand rejected under 35 U.S.C. 103 (a) as being unpatentable over Fortin. The basis of the Examiner's assertion is that it would have been obvious to remove the slits (19 and 20) from the guard of Fortin to provide a stronger, stiffer, less expensive guard and shoe. However, the Summary of Invention in Fortin specifically mentions that a purpose of the invention is to "facilitate flexion of the metatarsal guard" (col. 1, lines 66-67). Because the proposed amendment to Fortin would remove the flexibility function provided by the slits (19 and 20), it is not, we submit, a proper modification to Fortin.

Conclusion

The relatively complex metatarsal guards of Fortin and Kracjir et al indicate that neither patentee recognized that the simple metatarsal guard of the present invention would meet the industrial requirements for impact resistant safety shoes and also provide the required flexibility to the wearer of a safety shoe. For all the foregoing reasons, it is respectfully submitted that claims 4-6 are patentable over the prior art of record.

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Respectfully submitted,



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